

IN THE DRAWINGS:

Please replace Fig. 7 with the replacement sheet attached. A marked-up copy of the figure being replaced is submitted herewith to locate the changes.

REMARKS

The Official Action of August 4, 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

A replacement for Fig. 7 has been provided which labels this figure as "Prior Art" in accordance with the Examiner's request at paragraph 1 of the Official Action. The specification has been amended to remove the basis for the objection at paragraph 2 of the Official Action.

Claims 1-9 drawn to a transferring pressure roll have been canceled. Claims 10 and 11 drawn to a transfer device and image recording apparatus have been rewritten with the recording material and transferring film positively recited as elements of the claim and with "means plus function" language defining other elements of the claim in accordance with the provisions of 35 USC 112, last paragraph. The recitation in the new claims of "a finely roughened surface" draws support from the specification as filed in, for example, the paragraph bridging pages 4 and 5.

The recitations in new claim 13 that the supporting body comprises a polypropylene film draws support from the specification at, for example, page 17, lines 10-11. The recitations in new claims 14-19 correspond with recitations in original claims 4-6 and 7-9. The recitations in new claim 21 correspond with recitations in original claim 3. The recitations in new claims 24-27 correspond with recitations in original claims 2,3 and 7-9. The recitations in new claims 28 and 29 draw support from the specification as filed at page 22, lines 13-19.

All of the claims as rewritten are respectfully believed to be free of the claim objections appearing at paragraphs 3 -4 and the claim rejection appearing at paragraph 6 of the Official Action, and are otherwise believed to be sufficiently definite to satisfy the dictates of 35 USC 112, second paragraph. With respect to the objection based on what is meant by "HA" in the term "HA 40 degrees", Applicants submit herewith an English translation of the JIS standard to which reference is made in the specification to show that the claimed term is well known to those of skill in the art.

Claims 1-3 of the present application were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3 of copending Application No. 10/675,866. Applicants respectfully traverse these rejections.

As discussed in MPEP Section 804, a double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. This means that to set forth a prima facie case of obviousness for the invention presently claimed, the claims of the co-pending application, when considered alone or in proper combination with another prior art reference or references, must show each and every limitation of the present claims (see MPEP Section

706.20(j)).

The present claims recite that the hardness of the recited elastic material is **HA 40 or more**, whereas the claims of the co-pending application require that the hardness is **less than HA 40**. Accordingly, the claims of the co-pending application, if considered as prior art with respect to the present claims, do not teach and in fact teach away from this claim limitation. The Examiner has cited no reference which could be properly combined with the claims of the co-pending application to arrive at the invention claimed herein, and indeed since the claims of the co-pending application teach away from the presently claimed hardness limitations, there can be no such proper combination. Accordingly, the presently claimed invention could not have been obvious from the claims of the co-pending application whereby the double patenting rejection should be withdrawn.

Claims 1-9 were rejected under 35 USC 102(b) as allegedly being anticipated by Kitagawa et al, but this rejection was not applied against the subject matter of claim 10, which was drawn to a transfer device comprising, for example, a press section, a peeling-off section, etc. It similarly does not apply to the new claims, which are all drawn to a transfer unit and positively recite elements, such as the recited press-bonding means, feed means and the recording material having a finely roughened surface with the recited characteristics, which are not shown in the reference.

Claims 10-11 were rejected under 35 USC 103(a) as allegedly being unpatentable

over Iwata in view of Kitagawa et al. Applicants respectfully traverse this rejection.

The claimed invention is based in part upon Applicants' finding that the claimed transferring unit, wherein the elastic material of the pressure roll has the claimed hardness, is capable of press-bonding a transferable protective layer onto an ink jet-recorded image formed on a finely roughened surface with a good adhesion and without causing the entrance of bubbles or substantial leveling of the roughened surface. This is shown by the Examples and Comparative Examples in the specification, as next discussed.

In Examples 1 and 2 described on pages 29-31 of the specification, laminated sheets comprising recorded material having a finely roughened surface were subjected to press-bonding, wherein the transfer roll was coated with a silicone rubber having a hardness of HA 80° (Example 1) or HA 50° (Example 2). In contrast, the press-bonding of laminated sheets of Comparative Example 1 described on page 31 of the specification was done with pressure rolls that were coated with silicone rubber having a hardness of HA 30°. Examples 1 and 2, and Comparative Example 1, were evaluated for (a) the entrance of bubbles into the protective layer (specification at page 32); (b) change of glossiness (specification at pages 32-33) and (c) attachment properties (specification at page 33). As discussed in the specification at pages 32-34, the results of the Examples were better than the results of the Comparative Example for each of the three (3) criteria evaluated. These results show the criticality of maintaining the elastic material of the pressure roll at the claimed hardness level when the transferring unit is used in connection with the recording material having a finely roughened surface as claimed.

The Examiner has acknowledged that the primary reference, Iwata, does not show the claimed hardness of the elastic layer of the transfer pressure roll, but contends that one of skill in the art would have been motivated by the secondary reference, Kitagawa et al, to use a pressure roll with an elastic layer of the claimed hardness to achieve fewer wrinkles and less looseness in the final laminated product. Applicants respectfully disagree.

First, Applicants respectfully note that the secondary reference relates to a film-applying apparatus for applying a film to a surface of a substrate exemplified by a substrate for a printed circuit board or a glass substrate of a liquid crystal display device or a plasma display device by laminating rolls (see Kitagawa et al at, for example, column 1, lines 9-13). Applicants respectfully submit that there is nothing, in the absence of the hindsight provided by the present specification, that would have motivated one of skill in the art to look to a film-applying apparatus designed for circuit boards and the like for pressure roller characteristics that would be suitable for applying a protective layer for coating an image on a recording medium.

This is especially true in a case where, as here, the claimed transferring unit comprises a recording material having a finely roughened surface with the recited characteristics. One of skill in the art would not apply to a recording material having a finely roughened surface a pressure that could result in leveling of the roughened surface. Accordingly, one of skill in the art would not look to Kitagawa for a suitable pressure roll for the Iwata device because it would be thought to be unsuitable.

In view of the above, it is respectfully submitted that there would have been no motivation to combine the cited references such that the references do not set forth even a *prima facie* case of obviousness for the invention as claimed. Accordingly, it is respectfully submitted that the prior art and all other rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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